

REMARKS

In the Office Action,¹ the Examiner:

- (1) objected to claim 26 because the preamble appears to be directed to a computer program;
- (2) rejected claims 1-10 under 35 U.S.C. § 101; and
- (3) rejected claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent Publication 2003/0212682 to Nip ("*Nip*") in view of U.S. Patent No. 5,940,809 to Musmanno et al. ("*Musmanno*").

By this reply, claims 1 and 26 are amended. No new matter is added by this amendment. Claims 1-11 and 17-26 remain pending.

I. Objection to Claim 26

In the Office Action, claim 26 is objected to because the preamble appears to be directed to a computer program. In an effort to advance prosecution and without acquiescing to the propriety of the objection, Applicants have amended claim 26 to recite "[a] computer-readable medium that stores a set of instructions which, when executed by a processor, performs a method for automatically filing documents relating to business transactions, the method comprising." Applicants respectfully submit that independent claim 26, as amended, is directed to statutory subject matter, and not a computer program per se. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the objection of claim 26.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. Rejection of Claims 1 - 10 under 35 U.S.C. § 101

Claims 1-10 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action alleges that the subject matter of independent claim 1 is a “[m]ethod claim merely having another statutory class in [the] preamble in absence of another statutory class does not render the claims statutory.” Office Action, page 2-3.

Although Applicants traverse the rejection as being improper, in an effort to advance prosecution and without acquiescing to the propriety of the characterizations of the claims, Applicants have amended independent claim 1 to recite “[a] computer-implemented method,” wherein various operations are performed using a processor or a storage device. Claim 1 is therefore tied to a particular machine and is clearly within the reach of 35 U.S.C. § 101. As such, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent claim 1 and dependent claims 2-10 under 35 U.S.C. § 101.

III. Rejection of Claims 1-11 and 17-26 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as being allegedly obvious over *Nip* in view of *Musmanno*. A *prima facie* case of obviousness has not been established with respect to the claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that

it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites, for example, “storing, using a storage device, the output data record with an identification code, wherein the output data record can be read in full or in part by the at least two business applications by referring to the identification code” *Nip* fails to teach or suggest at least this feature of claim 1.

The Examiner relies on *Nip* for its purported teaching of “storing” an output data record with an identification code. Office Action at page 3. Applicants disagree. *Nip* relates to a method and system of gathering and displaying user specified information,

where the display format is entirely specified by the user, and display specifications are stored. *Nip*, para. 10. According to *Nip*, a "requestor identifier/output table 114 contains a mapping from each unique requestor identifier-output identifier combination to the associated output specifications information in the output specifications database 117." *Nip*, para. 27. Further, *Nip* teaches storing "a mapping from each unique requestor identifier-output identifier combination" with "the associated output specifications information in the output specifications database 117." *Nip*, para. 27. The "output specification database" does not store any output data records. *Nip*, para. 23. "End-user input database 118" is the only database which stores user data. There is no database for storing an "output data record" in *Nip*.

Accordingly, *Nip* does not disclose or suggest "storing, using the computer, the output data record with an identification code" because *Nip* only discloses storing an input, not storing an output or a transformed output. Moreover, *Nip* fails to disclose or suggest storing a data record with an identification code.

Musmanno does not remedy the deficiencies of *Nip* with respect to independent claim 1. *Musmanno* assigns its UID when an input is received, and does not explicitly store an output, nor assign an identification code to an output. See *Musmanno*, col. 6, lines 1-24. Accordingly, because neither *Nip* or *Musmanno*, separately or in any proper combination, disclose or suggest "storing, using the computer, the output data record with an identification code," the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 1 and the rejection of claim 1 should be withdrawn.

Further, Applicants note that the purported combination of *Nip* and *Musmanno* is contrary to the teachings of these references and would not have rendered claim 1

obvious, as asserted in the Office Action. *Nip* is directed to a method and system of gathering and displaying user specified information, where the display format is entirely specified by the user, and display specifications are stored. In contrast, *Musmanno* is directed to a central asset management system that coordinates all transaction processing and uses a unique identifier (UID) for subsequent processing relating to a customer. *Musmanno*, Abstract. It would not have been obvious to combine the elements of *Musmanno* with that of *Nip* in view of their divergent teachings and, if they could be combined, such a combination would not have produced a "computer implemented method for automatically filing documents relating to business transactions to store data relating to a business transaction," as recited in claim 1. The Office Action does not establish otherwise. For this additional reason, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Independent claims 11 and 26, although of a different scope than claim 1, are also patentable over the cited references for reasons at least similar to those discussed above with respect to claim 1. Dependent claims 2-10 and 17-25 are also allowable at least in view of their dependence from independent claims 1 and 11, respectively. Accordingly, reconsideration and withdrawal of the rejection of claims 1-11 and 17-26 under 35 U.S.C. § 103(a) is respectfully requested and deemed appropriate.


CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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